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No. 99-1160

Supreme Court, U.S.
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IN THE
SUPREME COURT OF THE UNITED STATES

October Term

COMFORT SILKIE COMPANY CORPORATION,
Petitioner,

v.

ANNETTE L. SEIFERT,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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PARTIES TO THE PROCEEDING

The Petition accurately lists the parties to this proceeding.

TABLE OF CONTENTS

Page

PARTIES TO THE PROCEEDING i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iii

STATEMENT OF THE CASE 1

A. The Petition Misrepresents Uncontested Facts Regarding Public Use of Blankets Which Were Found to Invalidate the '285 Patent 1

B. The Petition Misrepresents the Evidence Which Was Before the District Court 2

REASONS WHY PETITION SHOULD BE DENIED 2

1. Neither the Decision Below nor the Record Support a Review of the Federal Circuit's Decision in a Patent Case 2

2. The Correctness of a Lower Court Decision is Not, Standing Alone, Enough for a Grant of Certiorari 3

3. The Federal Circuit's Interpretation of this Court's Precedent was Correct 4

CONCLUSION 6

TABLE OF AUTHORITIES

Page

Chicago & N.W. Tr. Co. v. Kalo Brick & Tile Co.,

50 U.S. 311 (1981) 4

Diamond v. Diehr,

450 U.S. 175 (1981) 3

Dow Chemical Co. v. Halliburton Oil Well Cementing Co.,

324 U.S. 320 (1945) 2

Egbert v. Lippman,

104 U.S. 333 (1881) . . . . . 3, 4, ... 5, 6

Minnesota Mining & Manufacturing Co. v. Appelton Papers, Inc.,

50 U.S.P.Q. 2d 1091 (D.C. Minn., 1999) 6

Ross v. Moffitt,

417 U.S. 600 (1974) 4

Watson v. Allen,

254 F.2d 342 (D.C. Cir., 1958) 5

The Respondent, Annette L. Seifert, respectfully requests this Court deny the Petition for Writ of Certiorari seeking review of the Federal Circuit's Opinion in this case. That Opinion identified as Case No. 98-1476 was decided July 16, 1999 and is not citable as precedent pursuant to Fed. Cir. R. 47.6.

STATEMENT OF THE CASE

This Petition seeks this Court's review of the Federal Circuit's Opinion affirming the decision of the United States District Court for the Central District of California granting summary judgment.

The evidence before the Federal Circuit was found to have established that blankets within the scope of the claims of United States Patent No. 4,989,285 ("'285 patent") were used in public more than one year prior to the filing date of the application which matured into the '285 patent. Most importantly, the Court found there was no dispute that the blankets were taken into public places with no expectation of privacy or confidentiality. As detailed hereinbelow, it is submitted there is no cause for this Court's review of factbound contentions of the Petition which have been rejected by the district court and the United States Court of Appeals for the Federal Circuit.

A. The Petition Misrepresents Uncontested Facts Regarding Public Use of Blankets Which Were Found to Invalidate the '285 Patent.

Petitioner's Statement of the Case attempts to negate the simple fact that the individuals to whom the blankets were given were members of the public and that these individuals had full access to the blankets being used in public more than one year prior

to the filing date of the application which matured into the '285 patent.

B. The Petition Misrepresents the Evidence Which Was Before the District Court.

Petitioner further appears to argue that the photographs offered into evidence had to provide the enabling disclosure in order to render the '285 patent invalid for public use under 35 U.S.C. §102(b). As recognized by the Federal Circuit, the photographs were merely documentary evidence which corroborated the testimony before the Court regarding the dates and locations of the multiple public uses of the blankets.

REASONS WHY PETITION SHOULD BE DENIED

1. Neither the Decision Below nor the Record Support a Review of the Federal Circuit's Decision in a Patent Case.

In 1992, Congress vested exclusive appellate jurisdiction in patent cases to the United States Court of Appeals for the Federal Circuit. By concentrating appellate review of all patent cases in a single forum with nationwide jurisdiction, Congress intended to eliminate both forum shopping and inconsistencies in appellate jurisdiction of patent matters. See, Sen.Rep. No. 275, 97th Cong., First Sess. 4-7, (1981) This eliminated any possibility of any conflicting views among federal appellate courts as to the validity of the same patent, a situation that had in the past merited Supreme Court attention on certiorari. See, Dow Chemical Co. v. Halliburton Oil Well Cementing Co., 324 U.S. 320, 322 (1945). Also eliminated was the need to grant certiorari to review a patent or infringement issue because of the circumstance of

litigation regarding that issue was likely to be confined within a single regional circuit. Since there no longer will be intercircuit conflicts as to the matters, patent issues that are decided by the Federal Circuit will only qualify for certiorari review if the issues are considered to be of importance.

Patent decisions of the former Court of Customs and Patent Appeals and the former Court of Claims were occasionally reviewed by the Supreme Court because of the intrinsic importance of the questions presented. See, Diamond v. Diehr, 450 U.S. 175, 181 (1981). in the absence of an intercircuit conflict, the importance of the issue raised in the Petition will be decisive in obtaining certiorari review.

The Petitioner has sought review of the Federal Circuit decision solely on the ground the Federal Circuit made an error, as a matter of law, when it relied on the decision of this Court's decision in Egbert v. Lippman, 104 U.S. 333 (1881). The Egbert case construed the issue of "public use" now the subject of 35 U.S.C. §102(b). As set forth hereinbelow, the Federal Circuit's reliance on the Egbert case was consistent with this Court's decision. Irrespective of this fact, since the decision creates no intercircuit conflict, and cannot be cited as precedent, it is submitted the decision lacks sufficient importance to justify a grant of certiorari.

2. The Correctness of a Lower Court Decision is Not, Standing Alone, Enough for a Grant of Certiorari.

It has been reiterated many times that the Supreme Court is not primarily concerned with the correction of errors in lower court decisions. Indeed, the correctness or erroneousness of the decision below is not meant to be the central focus of the

Supreme Court's exercise of its certiorari jurisdiction. As Justice Rehnquist said for the Court in Ross v. Moffitt, 417 U.S. 600, 616-17 (1974):

> "[T]his Court's review ... is discretionary and depends on numerous factors other than the perceived correctness of the judgment we are asked to review."

Although it is clear the Court has granted certiorari when a decision of a lower court is deemed to be erroneous, it is submitted such action is typically taken where the Court believes correction of an erroneous decision is of public importance. See, Chicago & N.W. Tr. Co. v. Kalo Brick & Tile Co., 450 U.S. 311 (1981). It is submitted that, in the absence of intercircuit conflicts or the importance of the decision on subsequent cases, a grant of certiorari should be denied. This is particularly true since the decision of the Federal Circuit is not citable as precedent.

3. The Federal Circuit's Interpretation of this Court's Precedent was Correct.

Petitioner seeks certiorari on the basis the Federal Circuit misconstrued this Court's decision in Egbert v. Lippman, supra. The argument of Petitioner is erroneous. Petitioner argues the Egbert case is "limited to a hidden use of the invention" and that finding public use requires "that the use did or was capable of putting the public into possession of the invention." The Egbert decision contains no such restrictions on its applicability. The Court found an invention was in public use where: (a) prior to the statutory grace period, the invention was presented to

an individual for her use; (b) no obligations of secrecy or any other conditions were imposed; and (c) the invention was not presented for the purpose of experiment nor to test the invention qualities. Egbert v. Lippman, supra, 104 U.S. at 337. The decision of the Federal Circuit in this case is fully consistent with the decisions of other appellate courts. For example, in Watson v. Allen, 254 F.2d 342, 345 (D.C. Cir., 1958), the Court held:

> "The statutory term 'public use' has been given an extraordinary meaning. In Egbert v. Lippman, the Supreme Court found public use where the inventor had given a novel corset stay to a lady friend. Thus, the fact that there is but one user, or the invention is given without profit, or that it is hidden from the public's eye, would seem to be immaterial. Nor need the user even realize he is using the invention ... It may be fair to conclude that public use exists where the invention is used by, or exposed to, anyone other than the inventor or persons under an obligation of secrecy to the inventor."

1100 (D.C. Minn., 1999), the Court, citing Egbert stated:

> "[T]hen, a single use of an invention by a single third party, even though the invention is not discernable to the unpracticed eye, will be a public use unless the inventor exercises adequate control over that use by the third party." (pg. 1101)

It is therefore submitted that, irrespective of any other issue purportedly raised by the Petition, the decision of the Federal Circuit was consistent with the decision in Egbert v. Lippman, supra.

CONCLUSION

For these reasons, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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